

REMARKS

This Response is submitted in reply to the Final Office Action mailed October 3, 2008 and in accordance with the telephone interview courteously granted to the Applicant's representative on December 16, 2008. Claims 1, 8, 10, 18, 19, 24, 25, 118 and 119 have been amended. Claims 9, 30, 88, 101, 102, 115 to 117, and 120 to 122 have been canceled. No new matter has been added by way of these amendments.

A Petition for a One-Month Extension of Time is submitted with this Response. A Request for Continued Examination is submitted with this Response. Please charge deposit account 02-1818 for the cost of the Extension of Time, the Request for Continued Examination and any other fees due in connection with this Response.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner provide an upcoming Office Action which will ". . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

The Office Action rejected:

1. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30, 88 to 117, and 121 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement;
2. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 6,193,606 to Walker ("Walker") in view of the teachings of Vancura, Martinez or Kilby and further in view of U.S. Patent No. 5,848,932 to Adams ("Adams"); and
3. Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 103 as being unpatentable over U.K. Patent No. 2,262,642 to Claypole et al. ("Claypole") in view of the teachings of Vancura, Martinez or Kilby and further in view of Adams.

1. The §112 Rejections

The Office Action states that “in the independent claims ‘a first outcome displayed to the player’ and ‘a second outcome displayed to the player’ fail to comply with the written description requirement.” Applicant submits that the support for these elements can at least be found on page 19, line 1 to page 22, line 31, on page 23, line 24 to page 24, line 26, on page 26, lines 1 to 26 and on page 37, lines 21 to 24.

Specifically, the specification discloses displaying a first outcome for the game of chance. As illustrated in Fig. 1, an outcome of a null symbol and a bonus symbol are displayed on a payline (90). This is a first outcome. The application states “[t]he slot machine can be a standard stepper-reel or video-reel which has a bonus feature.” (pg. 8, lines 20 to 23). These standard reel games result in a plurality of symbols being displayed to a player on at least one payline. These symbols on a payline are a first outcome. The application also states “[f]or example, in the case of reel slot machines, a special bonus pay symbol (or combination of existing symbols) could align on the payout line (or elsewhere in the window) of the slot machine.” (pg. 9, lines 14 to 17). Once again, the specification discloses a first outcome displayed to the player for the game of chance. Another example of displaying a first outcome is disclosed where the application states “when a player receives the bonus condition 80 on the payline 90.” (pg. 20, lines 23 to 28). The specification also states that the game chance may be “slots, joker poker, live card games, dice, wheel games, etc...” These games are all displayed to the player as is known in the art. Each of these games of chance produce a first outcome which is displayed to the player.

Regarding the second outcome, the specification discloses displaying the second game to the player in Fig. 1. Specifically, in this example embodiment, the player is provided an object such as shampoo bottle with a touchscreen with three options. An example of the bonus game, such as the Price is Right game “is shown to the player in a video display 110.” (pg. 21, lines 11 to 13) “The display processor 120 is interconnected to a display memory. The display memory 130 which selectively displays separate images in the video monitor 110.” (pg. 21, lines 19 to 23) Specifically, the database would need, at a minimum, the questions and correct responses.” The display memory includes items that are displayed on the display

device. The display memory includes the correct responses. Therefore, these correct responses are a second outcome shown to the player.

Applicant has also amended the claims to provide the second outcome to the player to place the application in condition for allowance. Applicant believes that providing the second outcome to the player can include displaying the second outcome to the player in various embodiments.

The Office Action states that in Claim 88 "a plurality of first outcomes" fails to comply with the written description requirement. Applicant submits that the support for these elements can at least be found on page 37, lines 23 to 30 and on page 38, lines 1 to 25. These sections of the application disclose that the game of chance can be any conventional casino game such as "slots, joker poker, live card games, dice, wheel games, etc." In all of these games one or plurality of outcomes are displayed to players of these games. For example, in a slot game a plurality of symbols on a plurality of paylines are displayed to players. This is well known in slots games. It is unclear how slots would be played without showing a plurality of first outcomes to the player if the player chooses to play a plurality of paylines.

The Office Action states that support for claims 8, 10, 117, 120 and 121 cannot be found in the specification. As discussed during the interview, support for Claims 8, 10, 117, 120 and 121 can be found in the specification where it states, "[t]he values for BMAX and BMIN need not be fixed, hence identical for every visit to the bonus game. Rather, it can vary." The specification goes on to provide an example where Bmax is 50 randomly half the time and 100 randomly half of the time. It also states that can be similar for Bmin. (pg. 16, lines 6 to 14) There are many different other examples through-out the specification where Bmax and Bmin change. For example, in Example 1, the specification describes Bmax being a first value for a player purely guessing. For a second player, Bmax is "a second value for a player's expected return for always being correct." (pg. 10, line 27 to pg. 11, line 18). These are clear variances of the minimum and maximum thresholds for the bonus game.

Applicant requests that the rejections of Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30, 88 to 117, and 121 be withdrawn because Applicant has either pointed to supporting disclosure in the specification or the rejections were not proper.

2. The rejections over Walker in view of the teachings of Vancura, Martinez or Kilby in further view of Adams

Walker discloses a gaming system that enables a player to play a game of knowledge, such as a trivia game, while playing a slot game on a slot machine. The player can use successful trivia results to access higher reward levels with the slot game, with each reward level having progressively higher payouts for a given winning combination or a higher probability of a winning result. The trivia questions are stored in a question database after being obtained from a remote source.

More specifically, the Walker gaming system includes a plurality of gaming machines, a probability table and a plurality of paytables. The probability table includes each possible reel combination and number ranges assigned to each possible reel combination. The different paytables are associated with different reward levels which are determined by predefined criteria. The gaming system monitors a player's trivia question performance to determine the player's payable for the slot game. If the player meets certain predefined criteria, the gaming system moves the player up a reward level. For example, every time the player answers three correct trivia questions, the player moves up a reward level and thus a different payable.

In a play of the game, a player presses a spin reels button. The gaming system generates a number via a random number generator. The gaming system determines the current reward level based on the player's trivia results and looks up the number on the appropriate probability table to determine a reel combination. The gaming system causes the reels to spin and to stop spinning to generate and display the determined reel combination. While the reels are spinning, the gaming system provides the player a trivia question. Based on the identified slot outcome and the player's answer to the trivia question, the gaming system locates the appropriate payable and determines a single award for the player. The single award in Walker is dependent on the randomly generated outcome for the slot game and additionally dependent on the trivia game.

For example, the Walker gaming system randomly generates a number and matches the number on the probability table to a symbol combination of bar/plum/plum. A first payable provides an award of 14 for not answering the trivia question, an award

of 18 for a correct trivia answer and an award of 12 for an incorrect trivia answer. A second payable provides an award of 14 for not answering the trivia question, an award of 20 for a correct trivia answer and an award of 12 for an incorrect trivia answer. The payable used in determining the outcome for the player is based on the player's reward level.

Vancura, Martinez and Kilby are publications disclosing the general concept of a house advantage in gaming. More specifically, the Office Action uses Vancura to support the allegation that a casino does not want to lose money.

The Office Action relies on Kilby to support the allegation that player skill level is probability the most significant determinant of hold.

The Office Action relies on Martinez to disclose the house percentage fluctuates depending upon the skill of the player. Martinez states that the house advantage of "blackjack fluctuates between .5 and 4 percent on average depending on the skill of the player." The Office Action also uses Martinez to support the allegation that "[o]ne consideration is the player skill as discussed above, not only to make sure that the house does not loose money, but also to make sure they do 'not pummel the clientele, and they will not return nor will anyone else visit after the word gets out.'"

Adams discloses:

[g]aming devices comprising a standard gaming unit, e.g., three reels, and a discernible additional payout indicator, e.g., a rotatable wheel. A preferred bonus payout indicator is clearly visible by the player and is actuatable when the reels of the slot machine stop on certain predetermined indicia. A preferred embodiment further comprises a payout multiplier which displays a plurality of values by which a payout may be multiplied.

According to the most preferred embodiments, a bonus payout indicator is clearly visible to a player and is operable when primary reels of a primary game slot machine stop on certain predetermined indicia. According to one preferred embodiment of the present invention, a secondary payout indicator is in the form of a rotatable bonus wheel which can be caused to spin automatically or in response to some action by a player, e.g., the player pushing a button, when the primary game indicates one of a predetermined plurality of indicia. The wheel is caused to gradually reduce speed and when the wheel stops, a pointer indicates the payout to be awarded to the player.

Another preferred embodiment of the present invention further comprises a discernible multiplier which provides the ability to change either the payout from

the primary gaming unit or the secondary payout indicator, or both. As described in more detail below, it is within the scope of the present invention to provide a payout from the primary gaming unit, a payout indicated by the secondary indicator only, a payout from the primary gaming unit or the secondary indicator as changed by the multiplier, or a separate, plurality of payouts from the primary gaming unit and the secondary indicator either with or without modification by a multiplier.

While the illustrated payout multiplier of the illustrated embodiments is in the form of an electronically selected value, it is also within the scope of the present invention to have a multiplier which involves some skill on the part of a player. For example, according to an additional preferred embodiment of the present invention, a player will shoot actual projectiles, such as coins, at one or more targets in an effort to increase the value of the multiplier. In any of the embodiments of the present invention utilizing a multiplier, the multiplier can affect the value of a payout from the standard gaming unit, the additional payout indicator, or both the standard gaming unit and the payout indicator. ...

The multiplier of Adams may be based on the skill of a player and changes an award based on a randomly generated game outcome. The multiplier of Adams "can affect the value of a payout from the standard gaming unit, the additional payout indicator, or both the standard gaming unit and the payout indicator." Adams does not render obvious an underlying game of chance that results in a first outcome, wherein if the first outcome results in a first payout, the first payout is provided to the player even if the second payout is not provided to the player and if the second outcome of a knowledge-based bonus game results in a second payout, the second payout is provided to the player even if the first payout is not provided to the player. In Adams, the multiplier is provided as a modifier of another award to a player. Adams does not render obvious providing an award from a skill game that results in an award separately payable to a player. In Adams, the multiplier that is earned by the skill of the player is provided to the player with another award.

The Office Action states that the claim language only infers a first and second payout as opposed to providing a positive recitation. While Claim 1 does include a first outcome capable of resulting in a first payout, Applicant submits that the claim goes on to include providing the first payout to the player if the first outcome results in the first payout. Applicant respectfully disagrees with the Office Action's interpretation of Claim 1. Specifically, Claim 1 recites a first payout and a second payout. Claim 1 also

includes "if the first outcome results in the first payout, providing the first payout to the player even if the second payout is not provided to the player." Claim 1 additionally includes "if the second outcome results in the second payout, providing the second payout to the player even if the first payout is not provided to the player." Applicant disagrees that these claimed elements are not a "positive recitation." The Office Action's broad statement that "[m]ost broadly, any game is capable of resulting in a payout at the discretion of the game operator" is not a proper support for this rejection. The Office Action is ignoring multiple elements of the claim. Specifically, the Office Action requests that steps must be performed "such as a player "receiving" or being "provided" a first payout. Claim 1 includes the element of "providing the first payout to the player."

The Office Action proceeds to somewhat allege that even if the claims did recite a first and second payoff, Adams discloses separate payoffs. As discussed during the interview, Applicant is not clear how the Office Action suggests that Walker is modified by Adams to create two payoffs at all. As discussed during the interview, Applicant requests that this rejection be withdrawn because the Office Action fails to render the claims prima facie obvious.

More specifically, "[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" MPEP 2143.01. The purpose of Walker is to provide the player a single award based on two separate game outcomes. Specifically, the "player can preferably use successful trivia game results to access higher reward levels with the slot machine, with each reward level having progressively higher payouts for a given winning combination or a higher probability of a winning result or both." Walker proceeds to state "a further need exists for a slot machine that permits a player to use successful results with a game of knowledge to access higher reward levels with an associated slot machine, with each reward level having a progressively higher payouts for a given winning combination or a higher probability of a winning result." Taking the statement in Adams that "payouts may be separate" and incorporating the two payouts into Walker ruins the intended purpose of Walker. Applicant requests that

the rejection of Claims 1, 3, 8 to 10, 18, 19, 24, 25, and 88 to 122 under 35 U.S.C. 103 as being unpatentable over Walker in view of the teachings of Vancura, Martinez or Kilby and further in view of Adams be withdrawn because the proposed modification renders Walker modified unsatisfactory for its intended purpose.

Further, if the proposed modification changes the principle of operation of a reference, then the proposed modification is not sufficient to render the claims prima facie obvious. More specifically, Section 2143.01 of the MPEP states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." The principle of operation in Walker is that two separate outcomes are needed to produce a single payoff. One of the outcomes determines the payable and the other outcome determines which payout the player will receive from that selected payable. The player uses "successful trivia game results to access higher reward levels with the slot machine." In this manner, players "believe that their knowledge is increasing their odds of winning or results in higher payouts for a given winning outcome."

The Office Action proposes that Walker be changed to provide two payouts. However, such a modification changes the principle of operation of Walker. If this modification were made, the trivia game would not determine a reward level. The slot outcome would solely determine an outcome in Walker which changes the principle of operation of Walker. Also, the trivia outcome would solely determine a payout which changes the principle of operation of Walker. Applicant requests that the rejection of Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 under 35 U.S.C. 103 as being unpatentable over Walker in view of the teachings of Vancura, Martinez or Kilby and further in view of Adams be withdrawn because the proposed modification changes the principle of operation of Walker.

Applicant further submits that the Office Action improperly relies on hindsight reasoning as a justification for this obviousness rejection. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. When the Examiner fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the

claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. That is, even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. An Office Action cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. The notion that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to form the claimed invention.

In this case, the Office Action improperly used hindsight reasoning by stating that the elements of a game that uses two game outcomes to determine one award may somehow produce two awards. How the two awards are produced or are determined is not discussed in the Office Action. The Office Action simply states that "[p]ayouts in such a fashion are a matter of choice to the game designer and that Adams supports this position where the payouts may be separate." The Office Action is improperly picking and choosing individual elements from two separate gaming device patents and three articles to form the gaming devices of Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122. Such hindsight reconstruction of Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 is an improper basis for this obviousness rejection. Moreover, there is certainly no teaching, suggestion or motivation for: (1) starting with Walker, (2) then modifying Walker with Vancura and/or, (3) then modifying Walker with Martinez and/or (4) then modifying Walker with Kilby and (5) then modifying Walker with Adams. Accordingly, the rejections of independent Claims 1, 3, 8 to 10, 18, 19, 24, 25, 30 and 88 to 122 should be withdrawn.

Applicant has amended the claims as discussed during the interview. Specifically, Applicant has amended Claim 1 to include, in combination with other elements, causing the display device to display a play of a knowledge-based bonus game using answers inputted by the player which are dependent on the knowledge of the player and are inputted in response to a plurality of queries provided to the player, in

combination with the play of the underlying game of chance, wherein each query is associated with one of a plurality of different individual minimum values and one of a plurality of different individual maximum values, said play of said knowledge-based bonus game resulting in a second outcome provided to the player, said second outcome capable of resulting in a second payout to the player. Applicant has amended Claim 1 to include, in combination with other elements, said knowledge-based bonus game configured to maintain within a range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, wherein said range is defined by an overall minimum value and an overall maximum value and is configured to account for a first expected return provided by the play of the knowledge-based bonus game by the player guessing answers and a second expected return provided to the player having perfect knowledge of answers, wherein at least one of said overall minimum value and said overall maximum value are configured to change for different plays of the knowledge-based bonus game during a single gaming session by the player, wherein said overall minimum value and said overall maximum value are determined for each play of the knowledge-based bonus game based on the individual minimum values and individual maximum values associated with each of said plurality of queries provided to the player during said play of the knowledge-based bonus game and wherein at least two different queries which are associated with different minimum values or different maximum values are provided during two different plays of the knowledge-based bonus game.

Support for these amendments can be found at least on page 16, lines 6 to 14 and page 24, line 24 to page 25 lines 14 of the specification.

As discussed during the interview, Walker in view of the teachings of Vancura, Martinez or Kilby in further view of Adams does not render obvious causing the display device to display a play of a knowledge-based bonus game using answers inputted by the player which are dependent on the knowledge of the player and are inputted in response to a plurality of queries provided to the player, in combination with the play of the underlying game of chance, wherein each query is associated with one of a plurality of different individual minimum values and one of a plurality of different individual maximum values, said play of said knowledge-based bonus game resulting in a second

outcome provided to the player, said second outcome capable of resulting in a second payout to the player.

As discussed during the interview, Walker in view of the teachings of Vancura, Martinez or Kilby in further view of Adams does not render obvious the knowledge-based bonus game being configured to maintain within a range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, wherein the range is defined by an overall minimum value and an overall maximum value and is configured to maintain within a range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, wherein the range is defined by an overall minimum value and an overall maximum value and is configured to account for a first expected return provided by the play of the knowledge-based bonus game by the player guessing answers and a second expected return provided to the player having perfect knowledge of answers, wherein at least one of the overall minimum value and the overall maximum value are configured to change for different plays of the knowledge-based bonus game during a single gaming session by the player, wherein the overall minimum value and the overall maximum value are determined for each play of the knowledge-based bonus game based on the individual minimum values and individual maximum values associated with each of the plurality of queries provided to the player during the play of the knowledge-based bonus game and wherein at least two different queries which are associated with different minimum values or different maximum values are provided during two different plays of the knowledge-based bonus game.

For at least these reasons, Applicant believes that Claims 1, 3, 8, 10, 18, 19, 24, 25, 89 to 100, 103 to 114, 118 and 119 are patentably distinguished over Walker, in view of Vancura, Martinez or Kilby in further view of Adams and are in condition for allowance.

3. The rejections over Claypole in view of the teachings of Vancura, Martinez or Kilby in further view of Adam

Claypole discloses a gaming machine which has a reel display including three rotatable reels with fruit symbols and a video display screen. Elements of a trail system

are progressively illuminable by certain outcomes of a game played on the reels. Sufficient advancement of the illuminable trail elements initiates the display of a video game on a second display screen. In one embodiment, the award for reaching a particular advancement on the trail is a skill game which is played using another display screen. The skill game may be provided as an award based on the reel game. The skill game may be a quiz game providing an award for a correct answer. The skill game may be a shooting game which can provide an award dependent on the player's success in the shooting game.

As discussed during the interview, Claypole does not disclose or refer to payback percentages or ranges. Claypole does not disclose house advantages. Claypole does not disclose a range of house advantages. As discussed during the interview, Claypole in view of the teachings of Vancura, Martinez or Kilby in further view of Adams does not render obvious causing the display device to display a play of a knowledge-based bonus game using answers inputted by the player which are dependent on the knowledge of the player and are inputted in response to a plurality of queries provided to the player, in combination with the play of the underlying game of chance, wherein each query is associated with one of a plurality of different individual minimum values and one of a plurality of different individual maximum values, said play of said knowledge-based bonus game resulting in a second outcome provided to the player, said second outcome capable of resulting in a second payout to the player.

As discussed during the interview, Claypole in view of the teachings of Vancura, Martinez or Kilby in further view of Adams does not render obvious the knowledge-based bonus game being configured to maintain within a range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, wherein the range is defined by an overall minimum value and an overall maximum value and is configured to maintain within a range a second house advantage for the combined knowledge-based bonus game with the underlying game of chance, wherein the range is defined by an overall minimum value and an overall maximum value and is configured to account for a first expected return provided by the play of the knowledge-based bonus game by the player guessing answers and a second expected return provided to the player having perfect knowledge of answers, wherein at least one

of the overall minimum value and the overall maximum value are configured to change for different plays of the knowledge-based bonus game during a single gaming session by the player, wherein the overall minimum value and the overall maximum value are determined for each play of the knowledge-based bonus game based on the individual minimum values and individual maximum values associated with each of the plurality of queries provided to the player during the play of the knowledge-based bonus game and wherein at least two different queries which are associated with different minimum values or different maximum values are provided during two different plays of the knowledge-based bonus game.

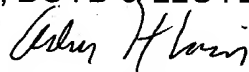
For at least these reasons, Applicant believes that Claims 1, 3, 8, 10, 18, 19, 24, 25, 89 to 100, 103 to 114, 118 and 119 are patentably distinguished over Claypole, in view of Vancura, Martinez or Kilby in further view of Adams and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, and such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY



Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: February 3, 2009